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EXAMINER

MARMOR II, CHARLES ALAN

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

DETAILED ACTION

1. This Office Action is responsive to the Amendment filed April 25, 2005. The Examiner acknowledges the amendment to claim 1 and the addition of new claims 23 and 24. Claims 1-24 are pending.

Drawings

2. The drawings were received on January 28, 2004. These drawings are acceptable.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 12, 13 and 17-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Higley ('375). Higley discloses an adaptor comprising a manifold (20) having a port (at 25) that is capable of being used as a suction port and ports (at 23, at 24, and attached the end of check valve bearing 23 that is most proximal to flow valve at 22) capable of receiving other medical devices. A flexible flow valve (in the vicinity of 22) is positioned in both a first flow path between a first device port and a second device port and a second flow path between the first device port and the suction port (see Figures 2 and 3). The suction port (at 25) is configured such that it is capable of connecting to a suction source. A first device port (at 24) is configured

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such that it is capable of accommodating an endoscope. The flexible flow valve (in the vicinity of 22) is a substantially flat membrane with an opening that is configured to increase due to fluid flow therethrough, a difference in pressure at proximal and distal sides of the valve, or due to an application of suction. The second device port is adjacent the flexible flow valve (at 22) and is connected to the check valve which bears a third device port (at 23) that is configured such that it is capable of connecting to another medical device. A second flexible flow valve (at 21) includes an opening and is located between the third device port (at 23) and both the second device port (described above) and the suction port (at 25).

Regarding claims 17-20, it has been held that "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4-11 and 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Higley ('375), as applied to claim 1 above. Higley teach the invention as recited for claim 1 but do not disclose detailed features of the valve. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the claimed valve features for the purpose of directing flow, since it was known in the art that any common valve in various positions would direct the flow as desired.

Response to Arguments

7. Applicants' arguments, see pages 7-12 of the Remarks filed April 25, 2005, with respect to the rejections of claims 1-3, 12, 13 and 17-22 under 35 U.S.C. 102(e) as anticipated by Crump et al. and of claims 4-11 and 14-16 under 35 U.S.C. 103(a) as being unpatentable over Crump et al. have considered but are moot in view of the new grounds of rejection. Applicants contend that Crump et al. fail to disclose or suggest at least an opening "configured to increase due to fluid flow from the first device port to the suction port. Applicants further argue that Crump et al. teach against such a configuration as such a configuration allegedly would impermissible render the device unsatisfactory for its intended purpose. These arguments are moot in view of the new grounds of rejection set forth hereinabove citing Higley. With regard to the rejections of claims 4-11 and 14-20, Applicants further state that Applicants do not necessarily agree with comments regarding the nature of dependent claims 17-20 or the section 103 rejection of dependent claims 4-11 and 14-16 set forth in the most recent Office Action and decline to subscribe to any statement or characterization in the Office Action. Since Applicants fail to set

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forth any specific reasons why these characterizations and rejections are improper, similar rejections citing Higley have been set forth in this Office Action.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles A. Marmor, II whose telephone number is (571) 272-4730. The examiner can normally be reached on M-TH (7:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571) 272-4726. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Charles A. Marmor, II
Primary Examiner
Art Unit 3736

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July 8, 2005